UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.

Petitioner

v.

SIGNAL IP, INC.,

Patent Owner

Case No. IPR2015-01116
Patent No. 6,012,007

PETITIONER'S REQUEST FOR REHEARING UNDER 37 C.F.R. §§ 42.71 (c) and (d)

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Under 37 C.F.R. §§ 42.71(c) and (d), Petitioner Volkswagen Group of America, Inc. ("VWGoA") respectfully requests rehearing of the September 29, 2015 Decision of the Patent Trial and Appeal Board ("the Board") denying institution of an *inter partes* review of U.S. Patent No. 6,012,007 ("the '007 patent"), based on VWGoA's Petition, filed on April 30, 2015 ("the Petition," Paper No. 2).

For the reasons more fully set forth below, VWGoA respectfully submits that the Board misapprehended or overlooked certain matters set forth in VWGoA's Petition and in the supporting Declaration of Dr. A. Bruce Buckman ("the Buckman Declaration," Ex. 1002), and respectfully requests that the Board institute an *inter partes* review of claims 1, 17, and 19 to 21 of the '007 patent.

II. LEGAL STANDARDS

In reviewing a request for rehearing, the panel "will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). The rehearing request must "specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." 37 C.F.R. § 42.71(d).

III. BASIS FOR RELIEF REQUESTED

A. The Board's Decision is Inconsistent with its Decision in IPR2015-01004

In its Petition, VWGoA presented an obviousness ground of unpatentability of claims 1, 17, and 19 to 21 under 35 U.S.C. § 103 in view of Cashler and Schousek. The Board's Decision denied institution on this obviousness ground. Yet, two days later, on October 1, 2015, the same Board instituted *inter partes* review of claims 1, 17, 20, and 21 based on anticipation under 35 U.S.C. § 102 by Schousek, the same prior art presented in VWGoA's Petition. *See* IPR2015-01004 ("the '004 IPR"), Paper No. 11. Thus, in the '004 IPR, the Board found that the subject matter of claims 1, 17, 20, and 21 is identically disclosed by Schousek, while in this proceeding, the same Board found that the combination of Cashler with Schousek fails to render these claims obvious.

The Board's decision to institute *inter partes* review of claims 1, 17, 20, and 21 based on anticipation by Schousek is inconsistent with the decision to not institute *inter partes* review of claims 1, 17, 20, and 21 based on obviousness in view of Cashler and Schousek. As the Federal Circuit has articulated, "a disclosure that anticipates under § 102, also renders the claim invalid under § 103, for 'anticipation is the epitome of obviousness.'" *Connell v. Sears, Roebuck Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

As an example of the inconsistent conclusions reached in this proceeding and in the '004 IPR, the portions of Schousek cited in VWGoA's Petition relating to "establishing a lock threshold above the first threshold" overlap the portions of Schousek cited in the '004 IPR petition. Yet, the Board, in this proceeding, found that Schousek does not disclose "establishing a lock threshold above the first threshold," but found, in the '004 IPR, that Schousek does disclose this limitation.

Because of the inconsistency between the decision to institute an *inter partes* review based on anticipation under 35 U.S.C. § 102 in the '004 IPR and the decision to not institute an *inter partes* review based on obviousness under 35 U.S.C. § 103 in the present proceeding, based on the same prior art cited in the '004 IPR, the Board should institute an *inter partes* review of the claims challenged in VWGoA's Petition.

B. Cashler and Schousek Render Obvious Claims 1, 17, and 19 to 21

In its Decision, the Board denied institution of an *inter partes* review based on its conclusion that it is unclear how the teachings of Cashler and Schousek "are combined in Petitioner's challenge to provide the 'lock threshold above the first

threshold' recited in claim 1."[1] Decision at 8. In doing so, the Board opined that the Petition does not "propos[e] any specific modification to Cashler," but "even assuming that one skilled in the art would have modified Cashler's system to include Schousek's fault detection process, Petitioner fails to provide any explanation as to how, or even allege that, Cashler's 'high threshold' would be used in that process to meet the claim limitations." Decision at 8.

In particular, the Decision states:

> There is no explanation in the Petition as to how Schousek's "maximum infant seat weight" is above Cashler's "high threshold" in the proposed combination. When discussing the "lock threshold [being] above the first threshold," Petitioner states that "Schousek teaches a 'maximum infant seat weight' threshold (*i.e.*, a 'lock threshold') that is above the 'minimum weight threshold,'" but does not tie Cashler's "high threshold" into the discussion of this limitation in any way.

Decision at 9 (citing Petition at 20).

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[1] The Board noted in its Decision that independent claim 17 is similar to claim 1, and declined to instituted *inter partes* review as to claim 17 (and claims 19 to 21, which depend from claim 17) for the same reasons as for claim 1.

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